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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/675,548
Filing Date: September 30, 2003
Appellant(s): STAVENJORD, WALTER KARL

Michael R. Krawzsenek
For Appellant

EXAMINER'S ANSWER

This is in response to the Board of Appeal Remand of 6/30/2009 to correct a signature issue.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

888530	PUGH	05-1908
4787185	GASCHO	11-1988

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Pugh (888530).

Pugh (figure 5) shows a casing system comprising a generally flat first casing piece (20 left) having an outer face, an inner face, a pair of linear side edges (where 34, 24, 22, 32 locate), a pair of linear end edges (where 31, 21, 33 locate), at least one of the linear side edges and at least one of the linear end edges being provided with a continuous decorative profile (the curving and grooves), a second casing piece (20 right) having an outer face, an inner face, a pair of linear side edges (where 34, 24, 22, 32 locate) and a pair of linear end edges (where 31, 21, 33 locate), at least one of the linear end edges being provided with a reverse image of the continuous decorative profile, the first piece being adapted to be joined to the second piece by engagement of the profile of the first piece to the reverse image of the profile of the second piece, both of the linear side edges of the first piece being provided with the decorative profile, both the end edges of the first piece being provided with the decorative profile, at least one of the linear edges of the second piece being provided with the decorative profile, both the linear end edges of the second piece being provided with the reverse image of the profile, at least one linear end edge is milled with the decorative profile and the other linear edge is milled with a reverse with a reverse image of the decorative profile, the decorative profile comprising a sloping surface extending from the upper face to the lower face in at least two stages (per the curve of a and b), each stage (the first

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stage being concave, the second stage being convex) of the sloping surface comprising a profile that is a convex profile and a concave profile, the outer face of the first piece having a decorative structure extending outwardly of the side and end edges (part 21 and part 23), at least one additional first casing piece and at least one additional second casing piece (inherently so as the casing piece 20 is lay continuously to cover a large surface), the upper face of the second piece having a decorative structure (where the top of part a is) extending inwardly of the end edges, an end edge of the first piece is adjoined to the end edge of the second piece by means of engagement of the decorative profile milled into the end edge of the first piece with the reverse image of the decorative profile milled into the end edge of the second piece.

3. Claims 1-5, 7-8, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Gascho (4787185).

Gascho (figure 4) shows a casing system comprising a generally flat first casing piece (top part) having an outer face (59), an inner face, a pair of linear side edges (where 70 is and the opposite side thereof) and a pair of linear end edges (the end faces of the top part), at least one of the linear side edge and at least one of the linear end edges being provided with a continuous decorative profile, a second piece (figure 4, the part as indicated by 54) having an outer face, an inner face, a pair of linear side edges and a pair of linear end edges, at least one of the linear end edges being provided with a reverse image of the continuous decorative profile (the reverse image of a flat surface is also a flat surface), both of the linear side edges of the first piece is provided with the decorative profile, both of the end edges of the first piece being provided with the decorative profile, at least one linear edges of the second piece being provided with the decorative profile, both of the linear end edges of the second piece being provided with the

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reverse image of the decorative profile, the decorative profile comprising a sloping surface (figure 2 shows the sloping surfaces per 22 and 18) extending from the upper surface to the lower surface in at least two stages, each stage of the sloping surface comprising a profile that is a convex profile and a straight linear profile, at least one additional first casing piece and at least one additional second casing piece.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pugh.

Pugh shows all the claimed limitations except for an instruction for assembling the parts to form a casing.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Pugh to show an instruction for assembling the parts to form a casing because it is well known in the art to provide instructions for assembling and installing parts on site as such practice would allow users to easily assemble parts together.

(10) Response to Argument

With respect to applicant's argument that "adapted to " language, examiner respectfully points out that the language was considered in light of the reference and the reference still reads on the claims as set forth. The language was considered and given little patentable weight as claimed.

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In response to applicant's argument that the references are not applicable as the floor tiles/wood log, are not for covering the gaps between vertical wall and frameworks of doors or windows installed therein, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The argument is thus moot.

With respect to applicant's argument that the language "adapted to" is not an intended use limitations but a structural limitation, examiner respectfully sets forth that applicant clearly is just claiming a casing system only. Applicant is not claiming structures that follow the language "adapted to" as has been clear from the prosecution history. The "adapted to" language was considered and given little patentable weight as it is clearly an intended use situation. The claim as set forth does not prevent applicant from using the casing system in another environment per se. The argument is thus moot.

With respect to applicant's argument that a person of ordinary skill in the art would not think to use the Pugh floor tiles as casing pieces to cover gaps between framing members, examiner respectfully sets forth that the references read on the structural limitations as claimed and capable of functioning as claimed. there is nothing in the structure that would prevent the structures from functioning as claimed. Also, the patent office has no way of limiting or controlling what a designer would do with his/her invention.

The statements to the "adapted to" language above also apply to the reference Gascho. Gascho shows all the limitations as claimed and there is nothing in the reference that would prevent the reference from being able to function as claimed. The argument is thus moot.

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With respect to applicant's statement that Gascho's features are not decorative, examiner respectfully sets forth that the ripples feature disclosed by Gascho is decorative; furthermore, whether or not a feature is "decorative" is subjected to a person's opinion, and many people would have many opinions of what would be considered "decorative". The argument is thus moot.

With respect to claim 16, the claim is a kit claim with instructions for assembly of the form casing. The reference as modified shows the limitations as claimed. Also, since the instructions(printed matter) are not functionally related to the structure of the kit, the claimed invention does not patentably distinguish from the prior art reference. In order for the printed matter to impart patentability to the kit, there must be a new and non-obvious functional relationship between the printed matter and some element of the kit; see court case *In Ngai*.

In response to applicant's argument that Pugh is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the prior art is to a structure that would provide a decorative surface on a surface area. The structure functions the same as applicant's invention as it is also to provide a decorative feature on a covered surface. Furthermore, Pugh's 103 rejection is purely to reject a printed matter set forth in the claim 16. the argument is thus moot.

With respect to claim 7 and 8, applicant states that the reference Pugh does not show the casing piece comprising a sloping surface extending from the upper face to the lower face in at

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least two stages, examiner respectfully disagrees. As clearly set forth in the action above, the stages are from curve a to curve b; in other words, the upper face is located at the beginning of b and the lower surface is at the end of a. Applicant has not set forth any orientation for the structure in the claim, the claimed limitations are thus reasonably rejected above. Each stage having a profile of convex or concave. the argument is thus moot.

The claims 7-8 are also rejectable by the reference Gascho.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Phi D A/

Primary Examiner, Art Unit 3633

Phi Dieu Tran A

8/15/09

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